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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/783,410

02/14/2001

Reiner Kraft

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EXAMINER

O'CONNOR, GERALD J

ART UNIT

PAPER NUMBER

3627

MAIL DATE

DELIVERY MODE

06/14/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/783,410

Applicant(s)

Kraft et al.

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on February 6, 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on February 14, 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Preliminary Remarks***

1. This Office action responds to the appeal brief filed by applicant on February 6, 2007 in reply to the previous Office action on the merits, mailed March 1, 2004.
2. PLEASE TAKE NOTICE that the examiner handling this application has changed. The new examiner is *Jerry O'Connor*. The Group Art Unit number is unchanged and is still 3627.
3. In view of the appeal brief filed on February 6, 2007, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.
4. To avoid abandonment of the application, appellant must exercise one of the following two options:
  - (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
  - (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31. A new notice of appeal fee and appeal brief fee will not be required for applicant to appeal from the new Office action.

***Information Disclosure Statement***

5. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, “the list may not be incorporated into the specification but must be submitted in a separate paper.” Therefore, unless the examiner has cited the references on form PTO-892, they have not been considered.

***Specification***

6. The disclosure is objected to because it contains embedded hyperlinks and/or other forms of browser-executable code. Applicant is required to delete all such embedded hyperlinks and/or other forms of browser-executable code. See MPEP § 608.01.

7. The attempt to incorporate subject matter into this application by reference to third party websites (page 4, lines 13 and 14) is improper because the information that was available at the time the specification was written may or may not be the same information (if any) that is available at the websites today.

8. The disclosure is objected to because of the following informality: it appears that “the present may be used” (page 10, line 12) was intended to be --the present invention may be used--, which change will all be assumed for purposes of further consideration of the claims hereinbelow. Appropriate correction is required.

***Claim Objections***

9. Claims 1-20 are objected to because of the following informalities: it appears that “the catalogue items” (claim 1, line 8; claim 9, line 14; and claim 17, line 14) was intended to be --the catalog items--; and, that “and one” (claim 4, line 2) was intended to be --any one--, which changes will all be assumed for purposes of further consideration of the claims hereinbelow. Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

10. The following is a quotation of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 17-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 17-20 are drawn to a computer program *per se*. Computer programs *per se* intrinsically require no tangible physical structure, thus do not constitute tangible physical articles or other forms of matter. Therefore, computer programs *per se* are not considered to be statutory subject matter. To be statutory, a computer program must be: (1) coupled with or combined with some statutory physical structure, *and*, (2) produce or effect some useful, concrete, and tangible result.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

13. Claims 1-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Tavor et al. (US 6,070,149).

Tavor et al. disclose a method and system for providing a shopping proposal that enhances a merchant's existing database system, comprising: analyzing a catalog of items in the existing database system based on a set of predefined rules that correlate the items under certain conditions, to determine which of the items in the catalog are related to other items in the catalog, and to define a new set of relations between the catalog items; wherein each rule comprises an evidence and a conclusion, and leads to new associations between the catalogue items; applying the new set of relations to the existing database system to update the database

system by providing the new associations of the items in the database system; generating a shopping advisor knowledge database that comprises the new associations for each item of the existing database system; and offering automated, dynamic, and personalized shopping advice to the shopper based on a shopper query, by retrieving the new associations in the shopping advisor knowledge database, and items from the existing database system that have been related by the new associations (see, in particular, column 16, lines 17-37, and Figure 11).

Regarding claim 2, in the method and system of Tavor et al., analyzing the catalog of items in the existing database system is based on a set of predefined rules for a given line of items.

Regarding claim 3, in the method and system of Tavor et al., defining the new set of relations includes defining a set of properties for the catalog items.

Regarding claim 4, in the method and system of Tavor et al., defining a set of properties includes defining any one or more of color, size, or category.

Regarding claims 5 and 6, in the method and system of Tavor et al., applying the new set of relations includes: assembling catalog items based on a set of predefined rules that is independent of the merchant's industry; and, using an intermediate format to list items that have been related by the new associations.

Regarding claims 7 and 8, the method and system of Tavor et al. further includes using additional information available during a shopping session, the additional information being based on any one or more of: the shopper's browsing history or previous purchases (see, in particular, column 40, line 61 et seq.).

14. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Linden et al. (US 6,266,649).

Linden et al. disclose a method and system for providing a shopping proposal that enhances a merchant's existing database system, comprising: analyzing a catalog of items in the existing database system based on a set of predefined rules that correlate the items under certain conditions, to determine which of the items in the catalog are related to other items in the catalog, and to define a new set of relations between the catalog items; wherein each rule comprises an evidence and a conclusion, and leads to new associations between the catalogue items; applying the new set of relations to the existing database system to update the database system by providing the new associations of the items in the database system; generating a shopping advisor knowledge database that comprises the new associations for each item of the existing database system; and offering automated, dynamic, and personalized shopping advice to the shopper based on a shopper query, by retrieving the new associations in the shopping advisor knowledge database, and items from the existing database system that have been related by the new associations.

Regarding claim 2, in the method and system of Linden et al., analyzing the catalog of items in the existing database system is based on a set of predefined rules for a given line of items.

Regarding claim 3, in the method and system of Linden et al., defining the new set of relations includes defining a set of properties for the catalog items.



Regarding claim 4, in the method and system of Linden et al., defining a set of properties includes defining any one or more of color, size, or category.

Regarding claims 5 and 6, in the method and system of Linden et al., applying the new set of relations includes: assembling catalog items based on a set of predefined rules that is independent of the merchant's industry; and, using an intermediate format to list items that have been related by the new associations.

Regarding claims 7 and 8, the method and system of Linden et al. further includes using additional information available during a shopping session, the additional information being based on any one or more of: the shopper's browsing history or previous purchases.

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to the disclosure.
16. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is (571) 272-6787, and whose facsimile number is (571) 273-6787.

Official replies to this Office action may now be submitted electronically by registered users of the EFS-Web system. Information on EFS-Web tools is available on the Internet at: <http://www.uspto.gov/ebc/portal/tools.htm>. An EFS-Web Quick-Start Guide is available at: <http://www.uspto.gov/ebc/portal/efs/quick-start.pdf>.

Alternatively, official replies to this Office action may still be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies should be directed to the central fax at (571) 273-8300.** Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

June 8, 2007

A handwritten signature in black ink, appearing to read "Gerald J. O'Connor", followed by the date "6/8/07".

Gerald J. O'Connor  
Primary Examiner  
Group Art Unit 3627